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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,497	08/05/2003	Martin Grohman	34192	8665

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Hovey Williams LLP
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EXAMINER

SLACK, NAKO N

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,497

Applicant(s)

GROHMAN, MARTIN

Examiner

Naoko Slack

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-4, 6-23 is/are rejected.
7) ☒ Claim(s) 5 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

Interview

In view of applicant's telephonic interview with applicant's representative Tracy L. Bornman on March 17, 2006, the final office action mailed March 1, 2006 has been withdrawn. Ms. Bornman has brought to the examiner's attention applicant's Rule 1.131 affidavit filed June 20, 2005 which predates the prior art reference to Eberle, III used in the previous office action. Therefore, the final office action herein presented replaces the former final action and restarts applicant's period for reply.

Response to Amendment

In view of applicant's amendment received December 15, 2005, amendments to the specification and claims have been entered. New claims 17-23 have been entered. Applicant's arguments have been carefully considered but are not convincing in view of the new rejection necessitated by amendment. Examination of pending claims 1-23 is herein presented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-4, 6, 7, 20-22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by US Patent 5,941,040 to McAnallen et al.

Claim 1:

McAnallen et al. discloses a deck board comprising an elongated body (10) presenting a pair of similarly configured sides, each of the sides including a normally-upper lip and a normally-lower lip (above and below rebate 11, Figure 5), each of the sides including a longitudinal groove (11, Figure 5) defined between the normally-upper lip and the normally-lower lip, the groove including an inner-most surface representing the deepest portion of the groove, the normally-upper lip extending further from the inner-most surface than the normally-lower lip (Figure 5) and said normally-upper lip being approximate equal in height.

Claim 2:

The normally-upper lip extending at least about 10 percent further from the inner-most surface than the normally-lower lip (as best shown in Figure 5).

Claim 3:

The normally-upper lip extending at least about 20 percent further from the inner-most surface than the normally-lower lip (as best shown in Figure 5).

Claim 4:

The similarly configured sides are located on generally opposite sides of the body (column 4, lines 15-16).

Claim 6:

The body is formed of a cellulosic fiber and plastic (column 3, lines 34-36).

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Claim 7:

The normally-upper and normally-lower lips present opposing inwardly facing surfaces cooperatively defining at least a portion of the groove (11).

Claim 20:

The groove (11) lacks a recess operable to retain water.

Claim 21:

McAnallen et al. discloses a deck board comprising an elongated body (10) presenting a pair of similarly configured sides (column 4, lines 15-16), each of the sides including a normally-upper lip and a normally-lower lip (above and below rebate 11, Figure 5), each of the sides including a longitudinal groove (1) defined between the normally-upper lip and the normally-lower lip, the groove including an inner-most surface representing the deepest portion of the groove, the groove lacking a recess operable to retain water, and the normally-upper lip extending further from the inner-most surface than the normally-lower lip (Figure 5).

Claim 22:

The groove and the lower lip lack protrusions extending away from joists.

Claims 11-14, 16-19, 21-23 are rejected under 35 USC 102(b) as being clearly anticipated by US Patent 5,660,016 to Erwin et al.

Claim 11:

Erwin et al. discloses a deck system comprising a plurality of laterally spaced joists (column 1, lines 24-26), a plurality of substantially parallel boards extending

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across and supporting joists, each of the boards including a pair of generally opposite similarly configured sides, each of the sides including an upper lip (70), a lower lip (74), and a groove (68) defined between the upper and lower lips, the lower lip being disposed closer to the joists than the upper lip, the upper lip protruding further than the lower lip, and the groove lacking a recess operable to retain water.

Claim 12:

The groove includes an inner-most surface representing the deepest portion of the groove, the upper lip extending at least 10 percent further from the inner-most surface than the lower lip (Figure 1, column 4, lines 13-16).

Claim 13:

The groove includes an inner-most surface representing the deepest portion of the groove, the upper lip extending at least 20 percent further from the inner-most surface than the lower lip (Figure 1, column 4, lines 13-16). The upper lip appears to extend at least approximately 30% beyond the lower lip.

Claim 14:

Each of the boards is spaced from one another by 1/8 inch (column 7, lines 33-36).

Claim 16:

Each of the boards is formed via extrusion (column 4, line 22).

Claim 17:

The groove and lower lip lack protrusions extending away from the joists.

Claim 18:

The groove includes an inner-most surface representing the deepest portion of the groove and a bottom surface extending from the inner-most surface to the lower lip, the inner-most surface, bottom surface, and lower lip present a continuously downward slope (74, Figure 1).

Claim 19:

As measured from the inner-most surface (72), the upper lip and lower lip are approximately equal in height.

Claim 21:

Erwin et al. discloses a deck board comprising an elongated body presenting a pair of similarly configured sides (Figure 1), each of the sides including a normally-upper lip and a normally-lower lip (both lips extend normal to vertical sides 72), each of the sides including a longitudinal groove (68 and 69) defined between the normally-upper lip and the normally-lower lip, the groove including an inner-most surface representing the deepest portion of the groove, the groove lacking a recess operable to retain water, and the normally-upper lip extending further from the inner-most surface than the normally-lower lip (Figure 1).

Claim 22:

The groove and the lower lip lack protrusions extending away from joists.

Claim 23:

The groove includes a bottom surface extending from the inner-most surface to the lower lip, the inner-most surface, bottom surface, and lower lip present a continuously downward slope (74, Figure 1).

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,941,040 to McAnallen et al.

Claim 10:

Claim 10 is considered product-by-process claim; therefore, determination of patentability is based on the product itself. See MPEP 2113. The patentability of the product does not depend on its method of production. If the product-by-process claim is the same as or obvious from a product of the same prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed.Cir.1985).

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,941,040 to McAnallen et al.

Claims 8 and 9:

While McAnallen et al. does not specify the dimensions of the groove or the board body, such dimensions are considered matters of obvious design choice, as dictated by the size of the deck, material properties of the board, and consumer

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preferences. 1-inch and 2-inch deck boards are notoriously well known in the art.

McAnallen et al.'s groove is approximately 1/3 the thickness of the deck board (Figure 5); therefore, McAnallen et al.'s groove would be .5 inches on a board 1-1/2 inches thick.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,660,016 to Erwin et al. in view of US Patent 6,986,934 to Chen et al.

Claim 15:

While Erwin et al. discloses that the boards may be made of polyethylene (column 7, lines 20-25), Erwin et al. does not specify that the boards are formed of cellulose fiber and plastic material. However, cellulose fiber and plastic composite boards are well known in the art. Chen et al. teaches a thermoplastic plank comprised of wood fiber and polyethylene (column 4, lines 16-49) with the benefit of improved mechanical properties (column 12, lines 40-47). In view of Chen et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to form Erwin et al.'s deck board with a cellulose fiber and plastic material for the stated benefit of improved strength.

Allowable Subject Matter

Claims 5 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Final

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose current telephone number is 571-272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack
Primary Examiner
Art Unit 3635

NS
March 17, 2006